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09/965,157	09/27/2001	Baldev K. Bandlish	2001US005	6225

7590 08/06/2003

CLARIANT CORPORATION  
Industrial Property Department  
4331 Chesapeake Drive  
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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
	1712

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/965,157</b>	Applicant(s) <b>BANDLISH ET AL</b>
	Examiner <b>LOVERING</b>	Group Art Unit <b>1712</b>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on JAN. 15, 2002 & FEB. 25, 2003.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) 1, 2 AND 7-10 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 3, 4-6 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1-10 are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 2+3  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-2, drawn to a composition, classified in Class 106, subclass 1.29.

II. Claims 3-6, drawn to a method of making an inorganic solution, classified in Class 516, subclass 88.

III. Claims 7-10, drawn to an electrolytic method of making zinc metal, classified in Class 205, subclass 602.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed in Group II can make other solutions than those claimed in Group I.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as the standard ZnO/NaOH solution described by applicants on page 2.

Inventions II and III are related as process of making and process of using. As the process of making (invention II) and the product (invention I) have been found to be distinct from one another, restriction between invention II and invention III is proper. See MPEP § 806.05(i).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Richard Silverman on June 18, 2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-6. Affirmation of this election must be made by applicants in replying to this Office action. Claims 1, 2 and 7-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.<sup>s</sup>

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of

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inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Myerson et al. 5,759,503, esp. column 7, lines 19-38, which disclose preparing a solution of zinc oxide in 50-70% sodium hydroxide solution and subsequently diluting by a factor which preferably is 3-5. This would result in a zinc oxide solution having an NaOH concentration of 10-23.3%. 5. Claims 4 and 6 are rejected under 35 U.S.C. § 103(a) as being

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unpatentable over Myerson et al. above in view of Siu et al. 5,958,210. The especially pertinent portion of Myerson et al. is pointed out in the preceding paragraph. While Myerson et al. don't specifically disclose the use of potassium hydroxide in their starting solution, it would have been obvious to one skilled in the art at the time applicants' invention was made to substitute KOH for NaOH in the process of Myerson et al. above, with a reasonable expectation of success, since Siu et al. (column 3, line 61 - column 4, line 24, esp. column 4, lines 14-16) teach the interchangeability of the two alkali metal hydroxides.

6. The remaining references listed on the attached Forms PTO-1449 (two pages) and Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
August 4, 2003

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
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